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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/886,959	06/20/2001	Algirdas Avizienis	xAAA-02	5024	
38637	7590	08/12/2010	EXAMINER		
PETER I. LIPPMAN		BONZO, BRYCE P			
17900 MOCKINGBIRD DRIVE		ART UNIT		PAPER NUMBER	
RENO, NV 89508		2113			
		NOTIFICATION DATE		DELIVERY MODE	
		08/12/2010		ELECTRONIC	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALGIRDAS AVIZIENIS

Appeal 2009-003592
Application 09/886,959
Technology Center 2100

Before JAY P. LUCAS, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter “Request”) for reconsideration of our Decision mailed October 29, 2009 (hereinafter “Decision”).

In our Decision, we:

1. Affirmed the Examiner’s decision in rejecting claim 79 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Affirmed the Examiner’s decision in rejecting claims 2, 7, 12, 19, 24, 41, 54, 61, and 65-69 under 35 U.S.C. § 112, second paragraph, as being indefinite. However, we reversed the Examiner’s decision in rejecting claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite.
3. Affirmed the Examiner’s decision in rejecting claims 4, 16, 36, 47, 59, 66, and 82 under 35 U.S.C. § 112, fourth paragraph.
4. Affirmed the Examiner’s decision in rejecting claims 1, 4-8, 11, 13-17, 19, 20, 42, 44, 45, 47, 48, 53, 70, and 79 under 35 U.S.C. § 102(b) as anticipated by Best.
5. Affirmed the Examiner’s decision in rejecting claims 2, 3, 9, 10, 12, 18, 21-24, 33-38, 41, 43, 46, 49, 50, 51, 52, 54-59, 61, 65-69, 71, 73-75, and 80-83 under U.S.C. § 103(a) as unpatentable over the combination of Best and Avizienis.

We have reconsidered our Decision, in light of Appellant's arguments in the Request for Rehearing, and we find Appellant has not identified any points that the Board has misapprehended or overlooked therein. We decline to change our prior Decision for the reasons discussed *infra*.

Appellant requests reconsideration of the following issues:

1. Whether the Board's finding that the Best and Avizienis references were properly combined by the Examiner under § 103 constitutes a new grounds of rejection? (*See* Request 2-9 referring to our Decision at 26-27).
2. Whether the Board's interpretation of the word "such" in Appellant's claims is improper in light of a purported definition in Appellant's Specification? (*See* Request 10-11 referring to our Decision at 12-13, and 21).

Issue 1

Regarding the first issue raised by Appellant, it is our view that Appellant has not identified any points that the Board has misapprehended or overlooked.

An overriding principle of the Board is to ensure that appellants are afforded due process. In cases that come before the Board, "due process" means that the Board must ensure that appellants are given a fair opportunity to respond to the thrust of a rejection. *See In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005) (citing *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976)).

In the Request, Appellant attacks our reasoning in finding that the Examiner properly combined the Best and Avizienis references under § 103. (*See* Request 2-9 referring to our Decision at 26-27). Our reasoning in support of the Examiner’s proffered combination relies principally on the holding of the U.S. Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

In reviewing the record before us, we note that Appellant filed the Appeal Brief on January 24, 2007. On April 30, 2007 *KSR* was decided by the U.S. Supreme Court. The record shows that Appellant filed a Reply Brief on August 23, 2007 that specifically addressed *KSR* as an intervening controlling case.

In the Reply Brief, Appellant expressly admits that “*KSR* does seem to support the Examiner on the very narrow subject of ‘motivation’, per se, as well as ‘teaching’ and ‘suggestion.’” (Reply Br. 42) (underline added). Appellant goes on to suggest that the Board should substitute any kind of “common sense” test in place of a motivation test. (Reply Br. 43, ¶1). Thus, in our Decision we considered and addressed Appellant’s arguments (including arguments made regarding *KSR* in the Reply Brief) regarding the combinability of the references and found them unpersuasive for the reasons stated in our Decision at pages 26-27.

Moreover, Appellant had a second opportunity to raise any issue regarding *KSR* as an intervening case during the oral hearing that was held on October 6, 2009. An electronic word search of the official transcript of the hearing reveals that Appellant was silent regarding any mention of *KSR*. (*See* Official “Record of Oral Hearing,” mailed to Appellant on October 28, 2009).

Because the U.S. Supreme Court decision in *KSR* is an intervening controlling case, we do not agree that our reliance upon *KSR* (in finding that Best and Avizienis were properly combined by the Examiner) is a new ground of rejection. (Decision 27).² The decision by the Supreme Court in *KSR* is binding precedent upon all members of the Board and upon Appellant. Appellant was twice afforded a full and fair opportunity to address *KSR*: Firstly, in the Reply Brief, and secondly during the oral hearing conducted on October 6, 2009.

In the Request, Appellant further avers that he is not arguing the references individually but is merely “questioning the propriety of the combination.” (Request 3). We disagree. We again find Appellant is attacking the references in isolation. (*See* pages 29, 30, and 35 of our Decision). We note that the Examiner’s §103 rejection relies on the combination of Best and Avizienis.³

Moreover, we find Appellant’s statement in the Request (p. 2) that “Best’s hardware circuits do not operate any program to guard his system from failure” is directly contravened by Appellant’s previous statement in the principal Brief, as follows:

² See *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) (“It is well established that [a] mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection.”).

³ One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). (*See* page 29 of our Decision).

Best may teach circuit portions to detect and correct for failure, he makes explicit that his circuits are controlled by software, such as the "avionics" software that he mentions and the Examiner has noted - helpful to Best's purposes, as the software system is typically programmed to recognize what reasonable avionics communications look like.

(App. Br. 30).

Cf. also with Appellant's express statement made during the hearing: "That's the patent to Mr. Best, B-e-s-t, which says that his hardware system is to be operated by software, controlled by software." (*See* Official "Record of Oral Hearing," mailed to Appellant on October 28, 2009, p. 3, ll. 21-22).

We also note that Best expressly discloses that "RMU 40 is capable of being programmed . . ." (Col. 6, l. 3) (underline added).

Appellant also attacks our finding that Best and Avizienis are analogous art as being a new ground of rejection. (*Request 3 et seq.* referring to our Decision at 27).

We disagree. Our finding that Best and Avizienis are analogous art is merely our application of well established controlling case law to the facts of Appellant's appeal regarding the combinability of the references under § 103.⁴ It is not a new ground of rejection. *See Note 2 supra.*

On this record, it is our view that Appellant has been afforded full due process, including our additional consideration of Appellant's Request herein. For at least the aforementioned reasons, we disagree with Appellant that we have applied any new grounds of rejection in our Decision.

⁴ Whether a reference in the prior art is "analogous" is a question of fact. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). (*See* page 27 of our Decision).

Issue 2

Regarding the second issue raised by Appellant, it is our view that Appellant has not identified any points that the Board has misapprehended or overlooked.

35 U.S.C. § 112, fourth paragraph requires that “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” The Court of Appeals for the Federal Circuit has upheld the requirement for full compliance with the provisions of 35 U.S.C. § 112, fourth paragraph. *Pfizer, Inc. v. Ranbaxy Laboratories Ltd.*, 457 F.3d 1284, 1292 (Fed. Cir. 2006).

As stated in our Decision (11-13), we acknowledge that Appellant has the prerogative to be his own lexicographer. However, we are troubled by Appellant’s reliance on the word “such” to refer back to a claim element previously introduced in a parent claim. In particular, we agree with the Examiner that using “such” (instead of “said” or “the”) does not further limit the antecedent claim element in the parent claim. Instead, we conclude that the use of “such” actually broadens what has been previously claimed, because “such computing system” (claim 4) could be reasonably read on a different computing system (perhaps a similar computing system) than the particular “computing system” originally introduced in the preamble of claim 1.

In the Request (10-11), Appellant cites to the following portions of the Specification as purportedly providing an “explicit definition”:

(In the accompanying claims generally the term "such" is used, instead of "said" or "the", in the bodies of the claims, when reciting elements of the claimed invention, for referring back to features which are introduced in [the] preamble as part of the context or environment of the claimed invention. The purpose of this convention is to aid in more distinctly and emphatically pointing out which features are elements of the claimed invention, and which are parts of its context – and thereby to more particularly claim the invention.)
(Spec. 7, ll. 8-16) (underline in original).

For the first aspect of the invention introduced above, as noted already, the computing system as most broadly conceived is not a part of the invention but rather is an element of the context or environment of that invention. For a variant form of the first aspect of the invention, however, the protected computing system is a part of an inventive combination that includes the first aspect of the invention as broadly defined.
(Spec. 11, ll. 5-12) (underline in original).

We find the aforementioned portions of Appellant’s Specification to be unclear as Appellant discloses a variant form of the first aspect of the invention where the protected computing system is a part of an inventive combination that includes the first aspect of the invention as broadly defined. (Spec. 11, ll. 8-12).

We particularly observe that Appellant's Specification uses the phrase "first aspect of the invention as broadly defined." (Spec. 11, ll. 11-12). *Cf.* with Appellant's use of "explicit definition" in the Request. (Request 10) (underline added).

Appellant's arguments notwithstanding, we disagree that Appellant's proffered nomenclature regarding the use of the word "such" more particularly claims the invention, or serves to specify a further limitation of the claimed subject matter in the context of a dependent claim in accordance with the requirements of § 112, fourth paragraph.

On this record, we remain persuaded by the Examiner's reasoning and find Appellant's arguments to the contrary unavailing. (*See* Ans. 7).

CONCLUSION

We have considered the arguments raised by Appellant in the Request for Rehearing, but find none of these arguments persuasive that our original Decision was in error. It is our view that Appellant has not identified any points that the Board has misapprehended or overlooked. We are still of the view that the invention set forth in claims 1-24, 33-38, 41-59, 61, 65-71, 73-75, and 79-83 is unpatentable over the applied prior art based on the record before us in the original appeal. We have reconsidered our Decision but decline to grant the relief requested.

This Decision on Appellant's Request for Rehearing is deemed to incorporate our earlier Decision (mailed October 29, 2009) by reference. *See* 37 C.F.R. § 41.52(a)(1).

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ORDER

We have granted Appellant's request to the extent that we have reconsidered our Decision of October 29, 2009, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See also* 37 C.F.R. § 41.52(b).

REHEARING DENIED

pgc

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